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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,458	06/22/2000	Alan B. Hamor	3835-4002	8724

7590 12/03/2003  
Morgan & Finnegan  
345 Park Avenue  
New York, NY 10154

EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/598,458**

Applicant(s)  
**Hamor et al**

Examiner  
**James W. Myhre**

Art Unit  
**3622**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 30, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 30, 2003 has been entered.

### ***Response to Amendment***

2. The amendment filed on September 30, 2003 under 37 CFR 1.114 is sufficient to overcome the Angles et al (5,933,811) and Logan et al (5,721,827) references, but is ineffective to overcome the Gerszberg et al (6,044,403) reference.

### ***Claim Rejections - 35 USC § 112***

3. The amendment and arguments filed on September 30, 2003 has overcome the rejection of Claims 37,39,50,54,56, and 65 in paragraph 3 of paper number 10. The Examiner hereby withdraws that rejection.

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*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15, 30-36, 38, 44-49, 51-53, 55, 64, and 82-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811).

Claims 1, 30, 47-49, 51-53, 55, 64, 82-86, and 92-98: Angles discloses a system and method for delivering customized advertisements over interactive communication networks, comprising:

- a. Transmitting a controlling program to a client requesting content data (col 3, lines 25-29);
- b. Transmitting a content page to the client from a content provider (col 3, lines 9-17;
- c. Receiving client impressions (interactions) to the content page (col 3, line 66 - col 4, line 5); and
- d. Calculating content provider revenue based on the total number of client impressions from the content provider (col 4, lines 18-26).

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The Examiner notes that Angles discloses that the advertisement provider bills a plurality of advertisers (col 4, lines 3-5) and then monitors the number of advertisements viewed by consumers associated with a particular content provider so the advertisement provider can pay the content providers “based on the number of consumers who access their websites” (col 4, lines 20-22). Angles also discusses using the money collected from the plurality of advertisers to “pay an Internet provider based on the number of advertisements viewed by its consumers. The Internet provider can then use this advertising revenue to reduce the consumer access fees” (col 4, lines 43-46). However, while Angles implies that the advertisement provider maintains a “revenue pool” which contains monies collected from revenue sources (e.g. advertisers) and which is used to periodically pay the content providers (and others), it is not explicitly disclosed that the advertisers pay into the revenue pool prior to the client receiving the advertisements (client impressions). Official Notice is taken that it is old and well known for advertisers to prepay into an account prior to the delivery of their advertisements. As one example of this, persons or entities wishing to advertise on television, radio, or in a printed publication are normally required to pay for the advertising service before the advertisement is aired or printed. In another example, franchisees oftentimes must pay an “advertising charge” into a revenue pool (advertising account) of the franchiser, who then uses the monies collected from all of the franchisees to conduct nationwide advertising campaign, i.e. pay the content providers (television sand radio stations, newspapers, magazines, etc.). This same procedure has been taken “online” by advertisers as shown by Mayadas (US2001/0039515) in which the advertisers set up advertising campaigns,

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determine the cost of the campaign, and deposit funds into an escrow account at the message targeting system. The monies in the escrow account is then used to pay the appropriate entities for displaying, publishing, or reading the advertisements. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to required the advertisers in Angles to prepay monies into a resource pool (escrow/advertising account) prior to the system presenting the advertisements to the clients. One would have been motivated to utilize such a resource pool in order to facilitate immediate payments to the content providers without having to wait for the advertisers to receive and pay bills for the displayed advertisements.

Claims 2-6 and 87-91: Angles discloses a method for delivering customized advertisements over interactive communication networks as in Claims 1 and 85 above, and further discloses that the control functions include printing, saving, transmitting, and/or searching (col 20, lines 21-26 and col 23, lines 9-35).

Claims 7-10 and 32-35: Angles discloses a method for delivering customized advertisements over interactive communication networks as in Claims 1 and 30 above, and further discloses that the client impressions include delivering, printing, saving, or transmitting (col 16, lines 1-34).

Claim 11: Angles discloses a method for delivering customized advertisements over interactive communication networks as in Claim 1 above, but does not explicitly disclose that the host is always visible to the client when active. Official Notice is taken that it is old and well known within the computer arts to assign priorities to the windows being displayed to a client.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place a high priority on the host window to make it always visible to the client. One would have been motivated to keep the host visible to the client in order to increase the exposure of the client to the advertisement. Since the Applicant did not refute the above Official Notice in the response to the previous office action, it is taken as an indication of agreement that the feature is old and well known within the art.

Claims 12-14, 38, and 46: Angles discloses a system and method for delivering customized advertisements over interactive communication networks as in Claim 1 above, and further discloses targeting the advertisement based upon the client profile and preferences, accessed content, or the content page (col 15, lines 22-28).

Claims 15, 31, 44, and 45: Angles discloses a system, method, and computer program for delivering customized advertisements over interactive communication networks as in Claims 1 and 30 above, and further discloses that the total revenue pool comprises the total number of advertisements multiplied by the price per advertisement (col 16, lines 1-34).

Claim 36: Angles discloses a method for delivering customized advertisement over interactive communication networks as in Claim 30 above, and further discloses that the client impressions include searching (col 16, lines 1-34).

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6. Claims 16-29, 40-43, 57-63, and 66-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811) in view of Logan et al (5,721,827) and Blumenau (6,327,619).

Claims 16, 17, 27, 40, 42, and 43: Angles discloses a system and method for delivering customized advertisement over interactive communication networks, comprising:

- a. Grouping advertisements according to topic, user profiles, or other criteria (col 15, lines 39-42 and col 20, lines 59-63);
- b. Assigning/transmitting a controlling program (functional host) to a client (col 3, lines 25-29 and col 13, lines 61-67); and
- c. Transmitting a plurality of advertisements to the controlling program (col 15, lines 28-31).

Angles does not explicitly disclose that the plurality of advertisements are organized into an advertising wheel (i.e. queue), nor that the advertisements in the queue are transmitted to the controlling program in succession. Angles does, however, disclose updating the customized advertisement being viewed "if a particular consumer views a particular electronic page 32 for more than a minute, the advertising module 52 can send a new customized advertisement 30" (col 20, lines 11-17). Logan discloses a similar system and method for delivering customized advertisements over interactive communication networks and also discloses organizing the plurality of advertisements into a queue and transmitting a plurality of advertisements to the client in sequence from the queue (col 9, lines 57-63). Since an advertisement only appears once in the



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queue, it is inferred that the advertisement will only be transmitted once during each cycle of the queue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to organize linked advertisements in Angles into one or more advertising wheels/queues and to transmit each advertisement in the queue to the client in sequence once during each cycle of the queue. One would have been motivated to use an advertising wheel/queue in this manner in order to enable the system to present serial advertisements (similar to the old Burma Shave commercials alongside of American roadways for the past 50-60 years) in the proper sequence, to update the customized advertisement by sending the “new customized advertisement” in Angles without having to reinitiate the targeting sequence, and to preclude the repetitive delivery of the same advertisement.

While Angles does not explicitly disclose that the functional host is embedded in the content page, Blumenau discloses a similar system for presenting advertisement along with a content page in which the functional host (control reference) is added to the HTML coding of the content page prior to being transmitted to the user. The control reference then meters (tracks) the user’s exposure to the various displayed objects, such as advertisements, and transfers the collected data back to the central facility (col 5, line 13 - col 6, line 40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the controlling program in Angles to the HTML code of the content page. One would have been motivated to include the functional host with the content page in order to allow tracking of new

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clients who may have not previously accessed the system to download the functional host separately.

Claim 18: Angles, Logan, and Blumenau disclose a method for delivering customized advertisement over interactive communication networks as in Claim 16 above. Logan further discloses placing all of the similarly classified advertisements into one large queue (col 9, lines 57-63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place all of the similar advertisements in Angles in one large queue. One would have been motivated to use one large queue in order to ensure that an advertisement is not transmitted to the client more than once before all other similar advertisements have been transmitted.

Claims 19-26, 41, 57-63, and 66-73: Angles, Logan, and Blumenau disclose a system and method for delivering customized advertisements over interactive communication networks as in Claims 18 and 40 above. Logan further discloses that advertisements on one queue are subdivided into linked auxiliary wheels (sub-queues, according to various similar features (col 24, line 1 - Col 26, line 3). The various claimed features used to divide the advertisements are among the usual features used by advertisers when deciding how to target clients. The exact individual feature, or group of features, selected by the advertiser is a design decision which does not affect the steps of the invention. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to subdivide the advertisements in Angles into any number of linked sub-queues, based on whichever features the advertiser desires. One would

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have been motivated to subdivide the advertisements and to link the sub-queues in order to better target the advertisements to the client.

Claims 28 and 29: Angles, Logan, and Blumenau disclose a method for delivering customized advertisements over interactive communication networks as in Claim 16 above. Angles further discloses that the control functions include printing, saving, transmitting, and/or searching (col 20, lines 21-26 and col 23, lines 9-35).

7. Claims 74-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al (6,044,403) in view of Blumenau (6,327,619).

Claims 74 and 78: Gerszberg discloses a method for sending coupons to a client on a network, comprising:

- a. Transmitting a host with a face value (i.e. coupon) to a client (col 12, lines 18-48);
- b. Storing the coupon in the client's memory (col 12, lines 18-48); and
- c. Transmitting the coupon to a remote location (i.e. merchant), wherein the client receives a discount on goods or services according to the face value of the coupon (col 12, lines 18-48).

The Examiner considers the merchant as another client on the network. Thus, transmitting the coupon to the merchant is the equivalent of exchanging the coupon with another client. Additionally, since the coupon is being stored as a file in the client's memory (whether on

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a smart card or as part of some other type of client storage device) and no type of security procedure is disclosed which would prevent the transmission or copying of the file, it is obvious that the client could exchange (transmit and receive) these coupon files with any other client on the network to include other customers. One would have been motivated to allow customers to exchange of the coupon files in order to increase the likelihood of the coupon being redeemed.

While Gerszberg discloses receiving information from the Internet, he does not explicitly disclose that the coupon is embedded within a content page. However, Blumenau discloses a similar system for presenting an advertisement (e.g. coupon) along with a content page in which a functional host (control reference) is added to the HTML coding of the content page prior to being transmitted to the user (col 5, line 13 - col 6, line 40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to embed the advertisement in Gerszberg to the HTML code of the content page. One would have been motivated to include the advertisement with the content page in order to allow the content provider and advertiser to more easily track the number of exposures upon which to base the advertising fee paid to the content provider.

Claims 75 and 79: Gerszberg and Blumenau disclose a method for sending coupons to a client on a network as in Claims 74 and 78 above, and Gerszberg further discloses that the value of the coupon may vary while stored on the client's memory (col 12, lines 18-48).

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Claims 76, 77, 80, and 81: Gerszberg and Blumenau disclose a method for sending coupons to a client on a network as in Claims 74 and 78 above, but do not explicitly disclose that the value is an interest rate or a time value discount. Official Notice is taken that it is old and well known that coupons may consist of any number of innumerable terms to include, cents-off discounts, percentage discounts, rebates, various time sensitive terms, buy-one-get-one-free discounts, etc. Again, the exact terms and types of values offered would be a design decision made by each individual advertiser and would not affect the claimed delivery method. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the coupons being delivered in Gerszberg could contain any of these known terms to include an interest rate or a time value discount. One would have been motivated to allow the coupons to have various types of terms in order to expand the utility of the coupon delivery system to cover many types of advertisers. Since the Applicant did not refute the above Official Notice in the response to the previous office action, it is taken as an indication of agreement that the feature is old and well known within the art.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-98 have been considered but are moot in view of the new ground(s) of rejection.

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*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Himmel et al (6,317,782) discloses a system and method for embedding a Java applet into a content webpage in order to track the use of objects within the webpage.

B. Middleton, III et al (6,393,407) discloses a system and method for tracking interactions within webpage advertising using an embedded applet.

C. Mason et al (6,401,075) discloses a system and method for monitoring Internet advertising embedded within content webpages.

D. Blumenau (6,418,470) is a continuation of the patent used in the rejection above.

E. Brown et al (6,601,041) discloses a system and method for presenting targeted advertisements to online users using an exposure accounting module and a queue builder to manage content segment play lists (advertising wheels).

F. Shuster (US 2002/0019771) discloses a system and method for providing Internet advertising embedded within a content webpage.

G. Nolan et al (US 2003/0110210) discloses a system and method which displays advertisements along with content pages and monitors the state of the advertisements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

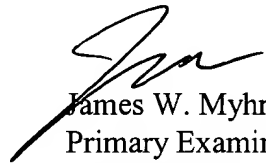
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
November 26, 2003



James W. Myhre  
Primary Examiner  
Art Unit 3622